UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VOLKSWAGEN GROUP OF AMERICA, INC.
Petitioner,

v.

WEST VIEW RESEARCH, LLC,
Patent Owner.

Case IPR2016-00125
Patent 8,290,778

PATENT OWNER'S REPLY TO PETITIONER'S RESPONSE TO MOTION TO AMEND

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I. Introduction

In *Volkswagen Group of America, Inc. v. West View Research, LLC*, IPR 2016-00125, Petitioner's Response to Patent Owner's Motion to Amend ("Response"), Paper 15, November 14, 2016, Petitioner fails to refute (i) the eligibility of the proposed substitute and new claims ("substitute claims") under §101; (ii) the patentability of the substitute claims over the art; (iii) that the amendments of the substitute claims are fully supported; (iv) that the amendments are responsive to a basis for patentability; and (v) that the substitute claims do not enlarge claim scope.

II. The Proposed Claims *Are* Directed to Patentable Subject Matter

Petitioner completely ignores the most recent and relevant precedent (i.e., the *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 2015-1180, slip op. (Fed. Cir. 2016), *Enfish LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed Cir. 2016), *Bascom Global Internet v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016), or *McRO, Inc. v. Bandai Namco Games Amer., Inc., et al.*, 837 F.3d 1299 (Fed. Cir. 2016) opinions from the CAFC) in its Section 101 analysis of its Response. All such precedent clearly cuts against both of Petitioner's positions that 1) the claimed subject matter is abstract under *Alice Corp. Pty. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014) Step One, and 2) there is no "inventive concept" under *Alice* Step Two.

Moreover, the District Court's analyses of the challenged '778 claims upon which Petitioner heavily relies had none of the benefit of any of the *later* guidance of *Amdocs*, *Enfish*, *Bascom*, or *McRo*, and was flawed in numerous ways, by: (i) adopting the position that any computer that provides information to a user is abstract under *Alice* Step 1, **a clear error under the later guidance of the CAFC**; (ii) failing to even *consider* that combinations of allegedly generic components may represent novel/non-obvious subject matter (in contravention of *Amdocs*, *Bascom* and *Enfish*); and (iii) failing to properly construe Patent Owner's claims in light of the disclosed data structures, hardware, and algorithmic flowcharts – **explicitly dismissing the latter as having no probative value**.

Moreover, no §112(6) inquiry was performed for '778 claim 30, **in direct contravention of *Amdocs***. (see *Amdocs* slip op. at 8, n.3), nor was the requisite "pre-emption" analysis under Step 1 or Step 2. Patent Owner's substitute claims are narrowly drawn and pre-empt only specific configurations.

To summarize the CAFC holdings supporting patentability of the claims:

1) Per *Enfish*, computer technology is not inherently abstract. *Enfish*, 822 F.3d at 1335. Nor is software, including associated logical structures and processes. *Id.* Petitioner cannot reconcile these holdings with the District Court's position that any computer that provides information is abstract under *Alice* Step 1. Petitioner's characterizing all the substitute claims as "collecting information,

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